



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/573,595

08/27/2008

Luca Castellani

10175.0001

2803

22852 7590 03/30/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

WOOD, KEVIN S

ART UNIT

PAPER NUMBER

2874

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/573,595	Applicant(s) CASTELLANI ET AL.	
	Examiner Kevin S. Wood	Art Unit 2874	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/24/2006</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Preliminary Amendment filed on 3/24/2006 has been entered. Claims 1-47 have been cancelled. New claims 48-94 have been added. Claims 48-94 are pending in the application.

### ***Specification***

2. The disclosure is objected to because of the following informalities: the use of an apostrophe ( ' ) as an abbreviation for minutes of time does not appear to be appropriate. The apostrophe typically symbolizes minutes of angle or geographical minutes (a minute of longitude or latitude). The ASTM D1238-00 standard involves flow rates of *grams per 10 minutes of time* (g/10 min.) Appropriate correction is required.

### ***Drawings***

3. The informal drawings are of sufficient quality to permit examination. The drawings are objected to because some of the reference numbers and figures appear to be drawn by hand (the lines lack uniform weight and thickness). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

Art Unit: 2874

should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 48-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of an apostrophe ( ‘ ) as an abbreviation for minutes of time does not appear to be appropriate. The apostrophe typically symbolizes geographical minutes (a minute of longitude or latitude). The ASTM D1238-00 standard involves flow rates of *grams per 10 minutes of time* (g/10 min.) The claims should be corrected so that it is clear what units of measure are being claimed.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 48-58, 61-74, 78, and 79**, are rejected under 35 U.S.C. 102(b) as being anticipated by **GB 2 149 411 A to Guerdoux** (hereafter referred to as the Guerdoux reference).

Referring to **claims 48-54, 61, 62, 65, 66, 71, 72, 78, and 79**, the Guerdoux reference discloses all the limitations of the claimed invention. The Guerdoux reference discloses a telephone cable comprising at least one core comprising at least one transmissive element (**conductor**) and at least one coating material, comprising: at least a first polyethylene (**copolymer A**) having a density less than  $0.940 \text{ g/cm}^3$  (**between 0.932 and 0.940 g/cm<sup>3</sup>**) and a fluidity index, measured at  $190^\circ\text{C}$  with a load of 2.16 Kg according to ASTM D1238 standard, of 0.05 g/10 min to 2 g/10 min (**not more than 1.5 g/10 min to 5 g/10 min**); and at least a second polyethylene having a density higher than  $0.940 \text{ g/cm}^3$  (**between 0.952 and 0.960 g/cm<sup>3</sup>**) and a fluidity index, measured at  $190^\circ\text{C}$  with a load of 2.16 Kg according to ASTM D1238 standard, of 0.05 g/10 min to 2 g/10 min or more specifically 0.1 g/10 min to 1 g/10 min (**0.15 g/10 min to 0.4 g/10 min**). See the entire Guerdoux reference.

Claiming either polyethylene is obtained from a waste material appears to be a Product by Process limitation. See MPEP 2113. Even though product-by-process

Art Unit: 2874

claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) process step within an apparatus claim. The source of the material does not appear to imply any structural difference over the prior art.

**Referring to claims 55-58 and 67-70**, the Guerdoux reference discloses all the limitations of the claimed invention. Each of these limitations appears to be directed to a property of the claimed materials. When the structure cited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent. See MPEP 2112.01. Since the Guerdoux reference has claimed a substantially identical structure with substantially identical materials, the properties of those materials are presumed to be inherent.

**Referring to claims 63, 64, 73, and 74**, the Guerdoux reference discloses all the limitations of the claimed invention. The Guerdoux reference discloses that the polymer composition comprises 50 to 60% the first polyethylene (**copolymer A**). Therefore the polymer composition comprises 40 to 50% the first polyethylene (**copolymer B**). See the entire Guerdoux reference.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 59, 60, and 75-77** are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 149 411 A to Guerdoux.

**Referring to claims 59, 60, and 75-77**, the Guerdoux reference discloses all the claimed limitations, including that carbon is added to the first polyethylene material and is therefore present in the polymer composition of the coating. The Guerdoux reference does not appear to teach the first polyethylene comprises carbon black in an amount of higher than 2% by weight, or the first polyethylene comprises carbon black in an amount of 2.5% by weight to 4.0% by weight, or carbon black is added to the coating material in an amount of 2% by weight to 5% by weight, or carbon black is added to the coating material in an amount of 2.5% by weight to 4.0% by weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the claimed amounts of carbon black, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Carbon black is commonly utilized as a reinforcing agent within rubbers and polymers. One of ordinary skill in the art would be motivated to select an amount of carbon black that is necessary to reinforce the polyethylene materials cited in the Guerdoux reference.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Wood whose telephone number is (571) 272-2364. The examiner can normally be reached on Monday-Thursday (7am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen-Chau N. Lee can be reached on (571) 272-2397. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSW

/Kevin S Wood/  
Primary Examiner, Art Unit 2874